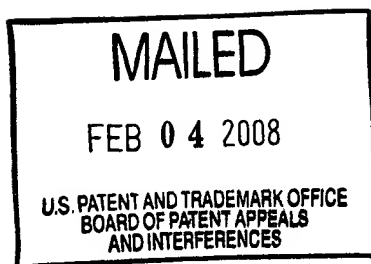


UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES



Ex parte JOSHUA J.D. MARTIN
and
INGRID M. SOLIS

Application 09/920,323

ORDER RETURNING UNDOCKETED APPEAL TO EXAMINER

This application was received electronically at the Board of Patent Appeals and Interferences on January 22, 2008. A review of the application has revealed that the application is not ready for docketing as an appeal. Accordingly, the application is herewith being electronically returned to the examiner. The matters requiring attention prior to docketing are identified below:

APPEAL BRIEF

A review of the Image File Wrapper (IFW) indicates that appellants filed an Appeal Brief on November 27, 2006. However, the Appeal Brief does not fully comply with 37 CFR § 41.37(c) (2006) which states:

(c)(1) The brief shall contain the following items under appropriate headings and in the order indicated in paragraphs (c)(1)(i) through (c)(1)(x) of this section, except that a brief filed by an appellant who is not represented by a registered practitioner need only substantially comply with paragraphs (c)(1)(i) through (c)(1)(iv) and (c)(1)(vii) through (c)(1)(x) of this section:

....

(iii) *Status of claims.* A statement of the status of all claims in the proceeding (e.g., rejected, allowed or confirmed, withdrawn, objected to, canceled) and an identification of those claims that are being appealed.

.....

(vii) *Argument.* The contentions of appellant with respect to each ground of rejection presented for review in paragraph (c)(1)(vi) of this section, and the basis therefor, with citations of the statutes, regulations, authorities, and parts of the record relied on. Any arguments or authorities not included in the brief or a reply brief filed pursuant to § 41.41 will be refused consideration by the Board, unless good cause is shown. Each ground of rejection must be treated under a separate heading. For each ground of rejection applying to two or more claims, the claims may be argued separately or as a group. When multiple claims subject to the same ground of rejection are argued as a group by appellant, the Board may select a single claim from the group of claims that are argued together to decide the appeal with respect to the group of claims as to the ground of rejection on the basis of the selected claim alone. Notwithstanding any other provision of this paragraph, the failure of appellant to separately argue claims which appellant has grouped together shall constitute a waiver of any argument that the Board must consider the patentability of any grouped claim separately. Any claim argued separately should be placed under a subheading identifying the claim by number. Claims argued as a group should be placed under a subheading identifying the claims by number. A statement which merely points out what a claim

recites will not be considered an argument for separate patentability of the claim.

....

(d) If a brief is filed which does not comply with all the requirements of paragraph (c) of this section, appellant will be notified of the reasons for non-compliance and given a time period within which to file an amended brief. If appellant does not file an amended brief within the set time period, or files an amended brief which does not overcome all the reasons for non-compliance stated in the notification, the appeal will stand dismissed.

(e) The time periods set forth in this section are extendable under the provisions of § 1.136 of this title for patent applications and § 1.550(c) of this title for ex parte reexamination proceedings.

The “Status of Claims” section appearing on page 2 of the Appeal Brief filed November 27, 2006 is deficient because it states that “[c]laims 1-16, 21 and 24-26 were finally rejected in a final Office Action dated March 9, 2006. These claims are the subject of this Appeal Brief.” However, it should be noted that page 9 of the Claims Appendix reflects that claims 7-10 were cancelled.¹ In addition, the “Argument” section appearing on pages 5 and 6 is deficient because each ground of rejection listed on page 4 of the

¹ While the initial page of the Final Rejection mailed March 9, 2006 states that “[c]laims 1-16, 21 and 24-26 is/are pending in the application,” page 2 properly notes that “claims 1-6, 11-16, 21, and 24-26 remain pending.” It should also be noted that the “Argument” section [pages 5-6] and the “Conclusion” [page 7] also include cancelled claims 7-10.

“Grounds of Rejection to be Reviewed on Appeal” (improperly entitled “Grounds of Rejection”) section must be treated under a separate heading. Correction is required.

EXAMINER’S ANSWER

The last rejection appearing on page 5 of the Examiner’s Answer mailed April 2, 2007 states:

Claims 1-6, 11-16, 21, and 24-26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Goodwin et al. (U.S. 2003/0220867 A1)(“Goodwin”).

However, according to the final paragraph on page 2 of the Notification of Non-Compliant Appeal Brief mailed November 15, 2006

The GROUNDS OF REJECTION portion is not correct, i.e. claims 1-6 were rejected under 35 USC 102(e). However, Appellants ARGUMENTS from page 5 of the Brief are noted. The Goodwin et al., US 2003-0220867, reference is not prior art. The application of Goodwin rejection is [an] unfortunate mistake as it clearly does not constitute prior art. Thus, if Appellant sends in a corrected Brief, the Goodwin reference is hereby withdrawn. The other rejections are, presently, still applicable.


Clarification regarding the status of the Goodwin reference is required. It should be noted that the Goodwin reference also appears on page 4 of the Examiner’s Answer as part of the “Evidence Relied Upon.”

Accordingly, it is

ORDERED that the application is returned to the Examiner:

- 1) to hold the Appeal Brief filed November 27, 2006 defective;
- 2) for notification to appellants to file a substitute Appeal Brief in compliance with 37 CFR § 41.37 which corrects the "Status of Claims," "Argument" and "Conclusion" sections with regard to the claims on appeal;
- 3) for consideration of the substitute Appeal Brief;
- 4) for clarification regarding the status of the Goodwin reference (2003/0220867) with respect to the 35 U.S. 103(a) rejection of claims 1-6, 11-16, 21 and 24-26; and
- 5) for such further action as may be appropriate.

BOARD OF PATENT APPEALS
AND INTERFERENCES

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Application No. 09/920,323

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